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Mickey Roemer

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EXAMINER

PIERCE, WILLIAM M

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICKEY ROEMER and DAVID B. SCHULTZ

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Appeal 2009-0448  
Application 10/662,605  
Technology Center 3700

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Decided:<sup>1</sup>March 24, 2009

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Before DONALD E. ADAMS, DEMETRA J. MILLS, and ERIC GRIMES,  
*Administrative Patent Judges.*

GRIMES, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a method for playing a game. The Examiner has rejected the claims as indefinite,

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

anticipated and obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm the rejection for indefiniteness but reverse the rejections based on the prior art.

### STATEMENT OF THE CASE

Claims 31-61 are on appeal.<sup>2</sup> Claim 31 is representative and reads as follows:

Claim 31: A method for playing a game, the method comprising:  
displaying a plurality of indicia-bearing game pieces on a gaming grid;  
receiving player input selecting game pieces that are adjacent to one another and that have matching indicia;  
removing from the grid the matching adjacent game pieces that are selected;  
after all matching adjacent game pieces that are perceived by a player are selected and removed, shuffling any remaining game pieces and presenting a new grouping of the remaining game pieces, the shuffling causing the remaining game pieces to be in a new random order, and the new grouping of the remaining pieces being in the new random order; and  
repeating the selection and removal of any matching adjacent game pieces.

The claims stand rejected as follows:

- claims 33 and 46 under 35 U.S.C. § 112, second paragraph, as being indefinite;
- claims 31, 32, 34, 45, and 60 under 35 U.S.C. § 102(b) as being anticipated by Monte Carlo;<sup>3</sup> and

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<sup>2</sup> Claims 62-97 are also pending but have been withdrawn from consideration as being drawn to a non-elected invention (Reply Br. 2).

<sup>3</sup> Walter B. Gibson, *Hoyle's Modern Encyclopedia of Card Games*, 1974, Doubleday & Co., New York, New York, pgs. 343-344 (Monte Carlo game).

- claims 33, 35-44, 46-59, and 61 under 35 U.S.C. § 103(a) as being obvious in view of Monte Carlo, Kelly,<sup>4</sup> and Same Game.<sup>5</sup>

### INDEFINITENESS

The Examiner has rejected claims 33 and 46 under 35 U.S.C. § 112, second paragraph, as being indefinite, on the basis that, in claim 33, the term “the prizes associated therewith” lacks a proper antecedent” and that claim 46 depends from cancelled claim 30 and “its scope cannot be determined” (Ans. 6).

Appellants do not dispute the Examiner’s rejection and state that they intend “to amend claim 33 to provide proper antecedent basis for the claim element when prosecution is re-opened” and “to amend claim 46 to properly reflect its dependency” (Reply Br. 4).

Given that Appellants do not dispute the rejection of claims 33 and 46 as being indefinite, we summarily affirm the rejection.

### ANTICIPATION

#### *Issue*

The Examiner has rejected claims 31, 32, 34, 45, and 60 under 35 U.S.C. § 102(b) as being anticipated by Monte Carlo.

The Examiner’s position is that Monte Carlo discloses a “grid of game pieces ..., player input selecting adjacent game pieces that have matching indicia ..., removing the game pieces ... and shuffling remaining game

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<sup>4</sup> Kelly et al., US 5,882,258, Mar. 16, 1999.

<sup>5</sup> Heins Palm Page, SAMEGAME, <http://www.geocities.com/ResearchTriangle/System/2771/Pilot/palmpage.html?20067> (downloaded July 7, 2006).

pieces after all matching adjacent game pieces have been selected,” and repeating the selection/removal process (Ans. 6). The Examiner reasons that the “action in the play of Monte Carlo of moving up the cards to fill in the empty spaces from the matching cards that were removed is considered to be a ‘shuffling’ process that causes ‘the remaining game pieces to be in a new random order’” (*id.*).

Appellants contend that the Examiner erred in finding that the disclosure in Monte Carlo of moving up cards to fill in the empty spaces meets the “shuffling” limitation because claim 31 requires the shuffling process to result in a new random order, and the shifted Monte Carlo pieces are in the same order (App. Br. 6).

The issue with respect to this rejection is: Does the evidence of record support the Examiner’s finding that Monte Carlo discloses a shuffling process that results in the remaining pieces being in a new random order?

#### *Findings of Fact*

1. Monte Carlo discloses a solitaire card game having an initial array, with exemplified cards, as shown below:

8	K	8	J	2
K	9	7	J	5
3	10	10	A	7
5	Q	6	6	A

(Monte Carlo 343.) The array has four rows with five cards in each row.

2. Monte Carlo discloses that adjacent pairs, touching horizontally, vertically, or diagonally, are removed from the initial array (*id.* at 344). The circled cards (shown below) would be removed from Monte Carlo’s exemplary array:

8	K	8	J	2
K	9	7	J	5
3	10	10	A	7
5	Q	6	6	A

3. Monte Carlo discloses that after adjacent pairs are removed, the remaining cards are moved up so that the initial array exemplified above becomes:

8	8	2	9	7
5	3	7	5	Q

(*Id.* at 344). The array has two rows with five cards in each row, and shows that each of the remaining cards was moved, in order, toward the top-left corner of the array.

4. Monte Carlo discloses that more cards are dealt to fill in the array to the required total of twenty and the pair removal procedure is repeated (*id.*).

5. Appellants' Specification discloses that the gaming method includes "shuffling any non-selected game pieces remaining within the game grid into a consolidated grouping" (Spec. 4: 12-14). Appellants' Figures 3 and 4 are reproduced below:

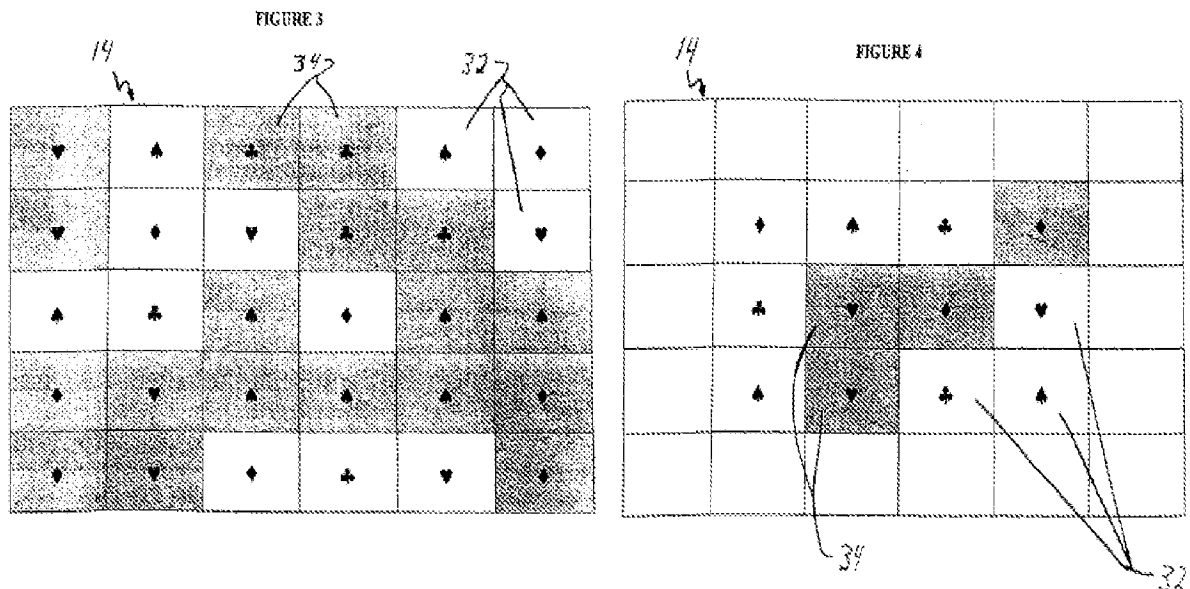


FIG. 3 is an exemplary display of one embodiment, according to the present invention, showing a gaming grid wherein matching adjacent game pieces are selected in a first selection period;

FIG. 4 is an exemplary display of one embodiment in a second selection period, according to the present invention, after the selection and removal of matching adjacent game pieces in Fig. 3, and *after the shuffling and consolidating of the non-selected game pieces from the first selection period.*

(Spec. 7: 9-15 (emphasis added).)

### *Principles of Law*

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art. “To anticipate a claim, a reference must disclose every element of the challenged claim.” *PPG Indus. Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996).

### *Analysis*

Claim 31 is directed to a method for playing a game that comprises, among other steps, removing matching game pieces that are adjacent to one another and shuffling any remaining game pieces to present a new grouping of the pieces in a new random order.

Appellants do not dispute that Monte Carlo discloses a game that comprises presenting indicia-bearing pieces on a grid and removing matching adjacent pairs, but Appellants contend that the Monte Carlo game does not disclose shuffling the remaining game pieces into a new random order.

The Examiner reasons that, after the pairs are removed, Monte Carlo discloses that the remaining pieces are moved up on the grid and that, “since the pieces are in a new location with respect to one another, this is considered to meet the recitation of ‘shuffling’ to create a ‘new random order’” (Ans. 6). We appreciate the Examiner’s position. Nevertheless, claim language must be interpreted in light of Appellants’ Specification.

Appellants draw a distinction between “shuffling” and Monte Carlo’s “consolidation.” As illustrated in Appellants’ Figures 3 and 4, the “shuffling” of game pieces requires a rearrangement in the order of the pieces (i.e., the creation of a new random order), not merely the consolidation of non-selected pieces that may remain after the first selection step (FF 5).

Therefore, Appellants’ arguments are persuasive. Monte Carlo discloses that the game pieces are moved up (i.e., consolidated), in the order in which they were originally displayed, to fill gaps left by removed cards. The new position of the pieces is therefore not based on shuffling that creates a new random order. The Examiner has not adequately explained how Monte Carlo discloses shuffling of the remaining game pieces to achieve a new *random* order.



The claimed game also differs from Monte Carlo in that it *requires* “repeating the selection and removal of any matching adjacent game pieces” (claim 31). Thus, even if the original array has no matching adjacent pieces, the method defined by claim 31 requires shuffling the remaining game pieces (including all of the original game pieces), presenting them in a new order, and allowing a second round of selection and removal of matching adjacent game pieces (see claim 31).

The rules of Monte Carlo, by contrast, do not provide for any shuffling and re-dealing of the cards if there are no matches in the original array. It is apparent from the rules of Monte Carlo that if the original array has no matching adjacent cards to remove, the game is over and the player loses; Monte Carlo therefore differs from the method of claim 31 in that it does not require repeating the selection and removal steps recited in the claim.

The anticipation rejection of claim 31 by Monte Carlo is reversed. Claims 32, 34, and 45 depend from claim 31. The rejection of these claims is reversed for the reasons discussed above.

Claim 60 is an independent claim and also requires that remaining pieces (i.e. “non-deactivated pieces”) are shuffled and presented in a “new random order.” The rejection of claim 60 is reversed for the reasons discussed above.

#### OBVIOUSNESS

The Examiner has rejected claims 33, 35-44, 46-59, and 61 under 35 U.S.C. § 103(a) as being obvious in view of Monte Carlo, Kelly, and SameGame.

Claims 33, 35-44, and 46-59 depend directly or indirectly from claim 31. Claim 61 is an independent claim and also requires that remaining pieces are shuffled and presented in a new random order. The Examiner relies on Monte Carlo, as discussed above, to meet the “new random order” limitation and provides Kelly and SameGame only to supply the additional limitations of the rejected claims. Thus, as discussed above, the Examiner has not adequately explained how the cited references show shuffling of the remaining game pieces to achieve a new random order, as required by all of the claims on appeal. The rejection of claims 33, 35-44, 46-59, and 61 in view of Monte Carlo, Kelly, and SameGame is reversed.

#### CONCLUSIONS OF LAW

The evidence of record does not support the Examiner’s conclusion that Monte Carlo discloses a shuffling process that results in the remaining pieces being in a new random order.

#### SUMMARY

We affirm the rejection of claims 33 and 46 under 35 U.S.C. § 112, second paragraph, as being indefinite.

We reverse the rejection of claims 31, 32, 34, 45, and 60 under 35 U.S.C. § 102(b) as being anticipated by Monte Carlo and the rejection of claims 33, 35-44, 46-59, and 61 under 35 U.S.C. § 103(a) as being obvious in view of Monte Carlo, Kelly, and Same Game.

Appeal 2009-0448  
Application 10/662,605

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

Ssc:

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